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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,775	08/28/2000	Italo O. Biaggioni	MBHB00-618-A	7733

20306 7590 10/10/2002

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EXAMINER

BERCH, MARK L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/10/2002

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/648,775

Applicant(s)

BIAGGIONI ET AL.

Examiner

Mark L. Berch

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1624

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See memo.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See memo.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 7,9,10 and 23.

Claim(s) objected to: _____.

Claim(s) rejected: 4-6,8,12-19 and 22.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Mark L. Berch
Primary Examiner
Art Unit: 1624

DETAILED ACTION

The amendment filed 9/18/02 under 37 CFR 1.116 in reply to the final rejection has been considered but is not deemed to place the application in condition for allowance and will not be entered because: The proposed amendment presents additional claims without canceling a corresponding number of finally rejected claims. The proposed amendment raises new issues that would require further consideration and/or search. For example, claim 25 is a much broader inflammatory method than the current inflammatory claims 6 and 9. Thus, the examiner would need to reinstate the previous rejection made on the presently canceled claim 11. Claim 26 presents a new category of diseases, and thus reinstatement of the original rejection of this category. Also, the clean copy of proposed new claim 26 has a word crossed out, which is not proper, and thus its scope is unclear. Claim 24 would clearly require fresh consideration of the Bonte reference. There may be other issues as well.

Applicants are correct, claim 8 is rejected as indicated on page 2.

The traverse of the obviousness rejection is unpersuasive. The reference says that the compounds "were obtained" and that would include compound Ic (Id is not relevant; the N is clearly a typographical error and should be H). The reference to "pyrrolidinyl" is not understood; the N-methyl-piperazinyl is assumed. If applicants wish to assert that the reaction with N-methyl-piperazinyl-COOH will not work, they need to present evidence. Further, the failure of a reference to provide a method of making is not necessarily fatal, so long as there is another method known prior to the relevant date. See *In re Sasse*, 207 USPQ 107; *In re Donohue*, 207 USPQ 196; *In re Donohue*, 226

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USPQ 619. In this case, the technique is long known. One halogenates, e.g. brominates, and then reacts with the amine, in this case, the N-methyl-piperazine.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 703-308-4718. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 708-308-1235.



Mark L. Berch
Primary Examiner
Art Unit 1624

October 3, 2002